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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 10/659,967   | 09/11/2003  | Duane G. Krzysik     | KCC 4982.1 (K-C 19,834) | 5034             |
| 321  | 7590        | 11/30/2006           | EXAMINER                |                  |
| SENNIGER POWERS<br>ONE METROPOLITAN SQUARE<br>16TH FLOOR<br>ST LOUIS, MO 63102 |             |                      | SHEIKH, HUMERA N        |                  |
|  |             |                      | ART UNIT                | PAPER NUMBER     |
|  |             |                      | 1615                    |                  |

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/659,967             | KRZYSIK ET AL.      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Humera N. Sheikh       | 1615                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 18 July 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1,3,5-13,15-23,25 and 27 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,5-13,15-23,25 and 27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### Status of the Application

Receipt of the Response and Amendment after Non-Final Office Action and Applicant's Arguments/Remarks, all filed 07/18/06 is acknowledged.

Claims 1, 3, 5-13, 15-23, 25 and 27 are pending in this action. Claims 1 and 23 have been amended. Claims 2, 4, 14, 24 and 26 have been cancelled. Claims 1, 3, 5-13, 15-23, 25 and 27 remain rejected.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1, 3, 5-13, 15-18, 21 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0497144 ('144) in view of U.S. Pat. No. 6,340,467 ('467) and further in view of U.S. Pat. No. 4,925,653 ('653).**

'144 teach cosmetic compositions comprising (1) a particulate styrene-ethylene-propylene copolymer, (2) an emollient, and (3) a pigment or sun blocking agent (abstract). According to '144, the styrene-ethylene-propylene copolymer may be present in an amount between 0.5% to 90% by weight, the emollient may be present in an amount between 10% to 70% by weight, and the colorant particles may be present in an amount between 5% to 50% by weight (page 3, line 43 - page 4, line 11). As set forth in Example 2, the styrene-ethylene-propylene copolymer may be admixed with isododecane, the colorant may be iron oxide, the sunscreen may be Titanium Dioxide, the texture modifier may be talc, and the emollient may be Isotetracone or Isododecane. Numerous other emollients, such as mineral oil, can also be used in the cosmetic composition advanced by '144 (page 2, line 55 - page 3, line 7). Additionally, based on the disclosure of '653, one would have the requisite motivation to add polyisobutylene to the cosmetic composition advanced by '144. According to '653, the addition of polyisobutylene to a skin care composition has the advantage of protecting human epidermis against UV radiation (column 1, lines 12-17).

Although '144 teaches that mixtures of emollients (such as mineral oil with a structurant - isoparaffins) can be used in the cosmetic composition, '144 does not specifically teach the same structurants as set forth in the instant claim set.

However, '467 teaches a composition comprising from about 5 ~ 75% weight percent of an emollient, about 0.1 to 50% by weight percent of a wax, and up to 50% weight percent of a rheology enhancer (Claims 1 and 13; abstract; column 2, lines 46-54; column 2, lines 37-41; and column 4, lines 34-42). According to '467, mineral oil is a suitable emollient (column 2, lines 24-36), carnauba wax is a suitable structurant (column 4, lines 34-43), and a combination of mineral oil and styrene copolymers is a well-suited viscosity enhancer (column 3, lines 3-62 and column 4, lines 63-67). Because, according to '467, the addition of between 0.1 to 50% by weight of wax, such as carnauba wax or beeswax, can modulate the melting point and softening point of a cosmetic-based composition, one of ordinary skill in the art would have been motivated to add between 0.1 to 50% of carnauba wax or beeswax to the composition advanced by '144. Based on the teaching of '467, there is a reasonable expectation that the addition of a wax, such as carnauba wax or beeswax, would effectively modulate the melting point and softening point of a cosmetic-based composition, resulting in a composition suitable for dispersion to consumers. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a suitable wax, such as carnauba wax or beeswax, to the cosmetic-based composition advanced by '144 in view of the teachings of '467.

**Claims 1, 3, 5-13, 15-23, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,149,934 ('934) view of EP 0497144 ('144).**

'934 teach a composition comprising from about 5 - 95 weight percent of an emollient, about 5 - 95 weight percent of a wax, and about 0.1 - 25 weight percent of a viscosity enhancer

(abstract and column 2, lines 10-37). According to '934, mineral oil is a suitable emollient (column 9, line 47) and beeswax is a suitable structurant (column 10, line 22). Like the instant claims 7-9, the viscosity of the composition advanced by '934 is between about 50 - 50,000 centipose (column 12, lines 42-53). The composition set forth by '934 can also comprise a variety of other chemical agents, such as antifoaming agents and fragrances (column 11, lines 24-60).

The composition advanced by '934 can also comprise a surfactant, such as sorbitan monooleate, and a hydrophilic skin care active, such as glycerin (column 11, line 16; column 11, lines 59-60; and column 9, lines 21-22). In another embodiment, the composition can include 20 - 75 weight percent of a particulate material, such as calcium carbonate (column 7, lines 3-17).

'934 does not specifically teach a rheology enhancer selected from the list set forth in the instant Claims 1 and 23.

However, '144 teaches the advantages of using rheology enhancers comprising styrene-ethylene-propylene copolymers admixed with Isododecane in a cosmetic compositions (Example 2 and page 2, lines 33-26). According to '144, cosmetic compositions comprising styrene-ethylene-propylene copolymers are effective substrates suitable for transfer and spreading on skin in a smooth fashion (page 2, lines 33-36). Moreover, another advantage of using styrene-ethylene-propylene copolymers in a cosmetic composition is that they render said composition relatively transfer proof, meaning that said composition will not flake-off the skin after application (page 2, line 33-36). Since the addition of styrene-ethylene-propylene copolymers to a cosmetic composition render said composition-relatively transferproof, meaning that said

composition will not flake-off the skin after application, one of ordinary skill in the art would have been motivated to add styrene-ethylene-propylene copolymers admixed with Isododecane to the ointment composition proposed by '934. Based on the teachings of '144, there is a reasonable expectation that a topical ointment comprising styrene-ethylene-propylene copolymers would result in a composition that is relatively transferproof, meaning that said composition will not flake-off the skin after application. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add styrene-ethylene-propylene copolymers admixed with Isododecaneto the cosmetic composition advanced by '934 in view of the teachings of '144.

**Claims 1, 3, 5, 6, 10-13, 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,287,581 ('581) in view of EP 0497144('144).**

'581 disclose a composition comprising 5 - 95 weight percent of emollients, 5 - 95 percent wax, a structurant, 1 - 25 weight percent of a viscosityenhancer, humectants, and 1 - 20 weight percent of a surfactant (abstract, column 3.,ilines 32-39, column 5, lines 18-32, and Claim 1). Specific components used in the invention advanced by '581 include: montan wax, a well known structurant (columns 5, line 13); canola oil, a suitable emollient (column 4, line 47); ethylene/vinylacetate copolymers, a viscosity enhancer (column 5, lines 16-17); sorbitan monooleate, a surfactant having an HLB in the range of 3 to 6 (column 5, lines 1-2, column 7, lines 4-15); glycerin a hydrophilic skin care active (column 5, line 7). The composition set forth by '581 can also comprise a variety of other chemical agents, such as antifoaming agents and fragrances (column 12, lines 11-44).

'581 does not specifically teach a rheology enhancer selected from the list set forth in the instant Claims 1 and 23.

However, '144 teaches the advantages of using rheology enhancers comprising styrene-ethylene-propylene copolymers admixed with Isododecane in a cosmetic compositions (Example 2 and page 2, lines 33-26).

According to '144, cosmetic compositions comprising styrene-ethylene-propylene copolymers are effective substrates suitable for transfer and spreading on skin in a smooth fashion (page 2, lines 33-36). Moreover, another advantage of using styrene-ethylene-propylene copolymers in a cosmetic composition is that they render said composition relatively transferproof, meaning that said composition will not flake-off the skin after application (page 2, line 33-36). Since the addition of styrene-ethylene-propylene copolymers to a cosmetic composition render said composition relatively transferproof, meaning that said composition will not flake-off the skin after application, one of ordinary skill in the art would have been motivated to add styrene-ethylene-propylene copolymers admixed with Isododecane to the ointment composition proposed by '581. Based on the teachings of '144, there is a reasonable expectation that a topical ointment comprising styrene-ethylene-propylene copolymers would result in a composition that is relatively transferproof, meaning that said composition will not flake-off the skin after application. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add styrene-ethylene-propylene copolymers admixed with Isododecane to the cosmetic composition advanced by '581 in view of the teachings of '144.

***Response to Arguments***

Applicant's arguments filed 07/18/06 have been fully considered but they are not persuasive.

**35 U.S.C. §103(a) Rejection of Claims 1-13, 15-18, 21 & 27 over EP '144 in view of U.S. '467 and further in view of U.S. '653:**

Applicant argued, "The '144 reference fails to disclose the specific rheology enhancers as required by claim 1. At best, the rheology enhancers disclosed in the '144 reference include isododecane in combination with styrene-ethylene-propylene copolymers. However, in Applicant's claim 1, when the rheology enhancer includes isododecane, the isododecane is used in combination with ethylene/propylene/styrene copolymers and butylene/ethylene/styrene copolymers. No where in the '144 reference is the use of butylene/ethylene/styrene copolymers taught or suggested. The Morrison and Grollier et al. references fail to overcome the above shortcomings. Nowhere is it disclosed to use isododecane in combination with ethylene/propylene/styrene copolymers and butylene/ethylene/styrene copolymers in either Morrison or Grollier."

Applicant's arguments have been considered, but were not persuasive. Admittedly, while the '144 reference does not disclose butylene/ethylene/styrene copolymers when used with isododecane, the reference does however, clearly recognize the use of a similar topical formulation that comprises similar ingredients, such as the rheological enhancing agents, emollients, structurants and the like. The fact that Applicant attempts to distinguish over the prior art by employing a slightly different copolymer combination does not render a patentable

distinction over the teachings of the art. The prior art vividly recognizes and teaches enhanced cosmetic compositions comprising similar ingredients as instantly claimed herein. The topical formulations of the art also provide for improved and beneficial results.

Applicant argued, “The Office States that one skilled in the art would be motivated to combine the polyisobutylene of Grollier et al. with the ‘144 and Morrison references simply because Grollier et al. disclose the addition of polyisobutylene to a skin care composition has the advantage of protecting human epidermis against UV radiation. This generic statement is not sufficient motivation for one skilled in the art to combine references and arrive at Applicant’s invention. Providing a sunblock agent to protect the skin from sunburn is merely an optional ingredient in the ‘144 reference. There is no motivation to use the polyisobutylene sunblock agent of Grollier over any other enormous number of sunblock agents described in the art.”

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the secondary reference of Grollier et al. was relied upon for the teaching that rheological enhancing agents, such as polyisobutylene, are commonly used in the cosmetic art and are used for their protective functions for human epidermis against UV radiation. The secondary reference, therefore provides ample motivation to employ polyisobutylene, since polyisobutylene is taught to be a suitable rheology enhancing agent for use in the art. The

argument that the use of a sunblock agent is an optional component in the '144 reference was not persuasive, since 'optional' is a positive suggestion, which cannot be ignored in the art.

Applicant argued, "It appears that the office has used impermissible hindsight analysis and reconstruction when combining the '144, Morrison and Grollier et al. references."

Applicant's arguments were not persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

**35 U.S.C. §103(a) Rejection of Claims 1-13, 15-23 and 25 over '934 (Krzysik) in view of EP '144:**

Applicant argued, "As noted by the Office, the '934 reference fails to teach or suggest the specific rheology enhancers as required by Applicant's claim 1. The '144 reference fails to overcome the above shortcomings, namely the '144 reference fails to teach or suggest the rheology enhancers as required by Applicant's claim 1. Nowhere in the '144 reference is it taught to combine isododecane with ethylene/propylene/styrene copolymers and butylene/ethylene/styrene copolymers as required by Applicant's claim 1."

These arguments were unpersuasive since the prior art teaches the use of similar ingredients, namely, rheology enhancers, structurants, emollients, etc., formulated in the same field of endeavor and to treat similar problems, as that desired by Applicants. The prior art recognizes the use of similar copolymer combinations in cosmetic formulations. Moreover, the Grollier et al. reference teaches the incorporation of rheology enhancers, such as polyisobutylene and thus remedies any deficiency of the '144 reference. Furthermore, Applicants have not demonstrated any superior or unexpected results, which accrue from the use of the specific copolymer combination when using isododecane. The prior art vividly teaches obtaining effective results using the copolymers described in the art therein.

**35 U.S.C. §103(a) Rejection of Claims 1-6, 10-13 and 19-22 over '581 (Krzysik) in view of EP '144:**

Applicant argued, "As noted by the Office, the '581 reference fails to teach or suggest the specific rheology enhancers as required by Applicant's claim 1. The '144 reference fails to overcome the above shortcomings, namely the '144 reference fails to teach or suggest the rheology enhancers as required by Applicant's claim 1."

The Examiner was not persuaded by this argument. The prior art teaches similar copolymer combinations of rheology enhancing agents that would impart similar results as that desired by Applicant's copolymer combinations. The fact that Applicant recites a slightly different copolymer combination does not render the instant invention patentable. Applicants have not sufficiently demonstrated how their formulation would provide for unexpected results over that of the teachings of the art of record. The prior art establishes cosmetic formulations

comprised of similar components that would yield effective results. No significant patentable distinction has been observed in Applicant's use of the ethylene/propylene/styrene copolymers and butylene/ethylene/styrene copolymers when used with isododecane. The formulations of the prior art are essentially the same as that being claimed by Applicant.

Given the explicit teachings of the art, the instant invention, when taken as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

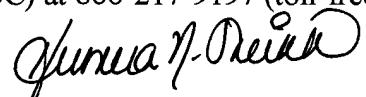
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday through Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HUMERA N SHEIKH  
PRIMARY EXAMINER

Art Unit 1615

November 25, 2006

*hns*